UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/696,942	10/30/2003	Larry W. White	DC-05626	9081

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EXAMINER
COUGHLAN, PETER D

ART UNIT	PAPER NUMBER
2129	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/21/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

PTOL-90A (Rev. 10/06)

	Application No.	Applicant(s)
Office Action Summary	10/696,942	WHITE ET AL.
	Examiner	Art Unit	
	Peter Coughlan	2129	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>26 December 2006</u>.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-24</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-24</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>11/30/2003</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

        1.☐ Certified copies of the priority documents have been received.

        2.☐ Certified copies of the priority documents have been received in Application No. _____.

        3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

Detailed Action

1.   Claims 1-24 are pending in this application.

35 USC § 101

2.   35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-24 are rejected under 35 U.S.C. 101 for nonstatutory subject matter. The computer system must set forth a practical application of that § 101 judicial exception to produce a real-world result. Benson, 409 U.S. at 71-72, 175 USPQ at 676-77. The invention is ineligible because it has not been limited to a substantial practical application. 'Identifying excursions', 'saving the excursions', determining if a solution exists' all are procedures that remain within solution network and display no practical application in the real world. The result has to be a practical application. Please see the interim guidelines for examination of patent applications for patent subject matter eligibility published November 22, 2005 in the official gazette.

In determining whether the claim is for a "practical application," the focus is not on whether the steps taken to achieve a particular result are useful, tangible and

concrete, but rather that the final result achieved by the claimed invention is "useful, tangible and concrete." If the claim is directed to a practical application of the § 101 judicial exception producing a result tied to the physical world that does not preempt the judicial exception, then the claim meets the statutory requirement of 35 U.S.C. § 101. Phrases such as 'identifying excursions to a general solution', 'saving the excursions within the solution network', and 'accessing' and 'determining ... an excursion solution exists' has no practical puspose or application within the real world.

The invention must be for a practical application and either:

1) specify transforming (physical thing) or

2) have the FINAL RESULT (not the steps) achieve or produce a

useful (specific, substantial, AND credible),

concrete (substantially repeatable/ non-unpredictable), AND

tangible (real world/ non-abstract) result.

A claim that is so broad that it reads on both statutory and non-statutory subject matter, must be amended, and if the specification discloses a practical application but the claim is broader than the disclosure such that it does not require the practical application, then the claim must be amended.

Claims that state functions concerning a solution network excursion system which is model based must be able to provide a real world purpose or function. What separates two separate software applications within a computer system is what they provide (practical application) to the user. There must be a result that is a practical application.

Claim Rejections - 35 USC § 102

3.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 8, 9, 16, 17 and 24 are rejected under 35 U.S.C. 102(e) (hereinafter

referred to as **Ferguson**) being clearly anticipated by Ferguson et al., U.S. Patent

Publication 20030130899.

Claim 1

Ferguson anticipates identifying excursions to a general solution on a system

model basis (**Ferguson,** ¶0154; 'System model basis' of applicant is equivalent to

'neural network' of Ferguson. 'Identifying excursions' of applicant is equivalent to

'training' of a neural network of Ferguson. 'To a general solution' of applicant is parallel

to having the neural network obtain a desired result.); saving the excursions within the

solution network on a system model basis (**Ferguson,** ¶0188; 'Saving the excursions' of

applicant is equivalent to setting the weights of the neural network.); and when

accessing the solution network, searching the solution network to determine whether an

excursion solution exists. (**Ferguson,** ¶0217 and ¶0218; 'Excursion solution' of

applicant is equivalent to 'post process results' of Ferguson.)

Claim 9

Ferguson anticipates means for identifying excursions to a general solution on a

system model basis (**Ferguson,** ¶0154; 'System model basis' of applicant is equivalent

to 'neural network' of Ferguson. 'Identifying excursions' of applicant is equivalent to

'training' of a neural network of Ferguson. 'To a general solution' of applicant is parallel

to having the neural network obtain a desired result.); means for saving the excursions

within the solution network on a system model basis(**Ferguson,** ¶0188; 'Saving the

excursions' of applicant is equivalent to setting the weights of the neural network.); and,

means for searching the solution network to determine whether an excursion solution

exists when accessing the solution network. (**Ferguson,** ¶0217 and ¶0218; 'Excursion

solution' of applicant is equivalent to 'post process results' of Ferguson.)

Claim 17

Ferguson anticipates a knowledge repository, the knowledge repository storing

information regarding general solutions to issues, the knowledge repository storing

information relating to excursions to general solutions, the excursions being searchable

on a system model basis (**Ferguson,** ¶0154, abstract ; 'System model basis' of

applicant is equivalent to 'neural network' of Ferguson. 'To a general solution' of

applicant is parallel to having the neural network obtain a desired result. 'Knowledge

repository ... regarding general solutions to issues' of applicant is equivalent to

'historical database and constructing training sets' of Ferguson. 'Being searchable' of

applicant is demonstrated by being able to 'search the historical database' of

Ferguson.); an excursion identifying module, the excursion identifying module

identifying excursions to the general solutions on a system model basis (**Ferguson,**

¶0154; 'Identifying excursions' of applicant is equivalent to 'training' of a neural network

of Ferguson.); a search module, the search module searching the solution network to

determine whether an excursion solution exists when accessing the solution network.

(**Ferguson,** ¶0217, ¶0218 and Figure 10; 'Excursion solution' of applicant is equivalent

to 'post process results' of Ferguson. 'Search module' of applicant is equivalent to

'Postprocess Results' (68) in Fig. 10 of Ferguson.)

Claims 8, 16 and 24.

Ferguson anticipates the system includes an information handling system.

(**Ferguson,** ¶0105; 'Information handling system' of applicant is equivalent to 'computer

system' of Ferguson.)

Claim Rejections - 35 USC § 103

4.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claim Rejections - 35 USC § 103

Claims 2, 3, 4, 10, 11, 12, 18, 19, 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ferguson, as set forth above, and further in view of Collins. (U. S. Patent Publication 20040243998, referred to as **Collins**)

Claims 2, 10 and 18.

Ferguson does not teach the excursions are identifiable based upon a unique system identifier.

Collins teaches the excursions are identifiable based upon a unique system identifier. (**Collins**, ¶0022; 'Excursions' and 'unique system identifier' of applicant is equivalent to 'corrupted' and 'unique identifier' of Collins.) It would have been obvious to a person having ordinary skill in the art at the time of applicant's invention to modify the teachings of Ferguson by using a particular identifier as taught by Collins to have teaches the excursions are identifiable based upon a unique system identifier.

For the purpose of narrowing the scope of search to a given system.

Claims 3, 11 and 19.

Ferguson does not teach the unique system identifier is a service tag.

Collins teaches the unique system identifier is a service tag. (**Collins,** ¶0022) It would have been obvious to a person having ordinary skill in the art at the time of applicant's invention to modify the teachings of Ferguson by using a service tag within the unique system field to focus in on a solution as taught by Collins to have the unique system identifier is a service tag.

For the purpose of setting forth the proper configuration of a particular unique system.

Claims 4, 12 and 20.

Ferguson does not teach storing the excursion exception within the solution network based upon a part identifier.

Collins teaches storing the excursion exception within the solution network based upon a part identifier. (**Collins,** ¶0022; 'Part identifier' of applicant is equivalent to 'express service code' of Collins. Collins states that corrupted software (excursion) is linked (identifiable) to an express service code. (part identifier)) It would have been obvious to a person having ordinary skill in the art at the time of applicant's invention to modify the teachings of Ferguson by linking the solution to the current situation characteristics as taught by Collins to store the excursion exception within the solution network based upon a part identifier.

For the purpose of obtaining a correct solution for a given excursion.

Claim Rejections - 35 USC § 103

5.   Claims 5, 6, 7, 13, 14, 15, 21, 22, 23 are rejected under 35 U.S.C. 103(a) as

being unpatentable over Ferguson, as set forth above, and further in view of Markham.

(U. S. Patent Publication 20030158795, referred to as **Markham**)

Claims 5, 13 and 21.

Ferguson does not teach storing the excursion exception within the solution

network based upon a system model identifier.

Markham teaches storing the excursion exception (**Markham,** ¶0008; 'Excursion

exception' of applicant is equivalent to 'event parameters' of Markham.) within the

solution network (**Markham,** ¶0043; 'Solution' of applicant is equivalent to 'maintenance'

of Markham.) based upon a system model identifier (**Markham,** ¶0081; 'System model

identifier' of applicant is equivalent to 'vendor' of Markham.)

It would have been obvious to a person having ordinary skill in the art at the time

of applicant's invention to modify the teachings of Ferguson by having routine

maintenance required based on vendor type as taught by Markham to store the

excursion exception within the solution network based upon a system model identifier.

For the purpose of using vendor type as an input parameter for maintenance

schedule.

Claims 6, 14 and 22.

Ferguson does not teach storing the excursion exception within the solution

network based upon a system manufacture date.

Markham teaches storing the excursion exception (**Markham,** ¶0008; 'Excursion

exception' of applicant is equivalent to 'event parameters' of Markham.) within the

solution network (**Markham,** ¶0043; 'Solution network' of applicant is equivalent to

'maintenance' of Markham.) based upon a system manufacture date. (**Markham,**

¶0081; 'System manufacture date' of applicant is equivalent to 'manufacture date' of

Markham.)It would have been obvious to a person having ordinary skill in the art at the

time of applicant's invention to modify the teachings of Ferguson by using

manufacturing date as a input parameter routine maintenance as taught by Markham to

store the excursion exception within the solution network based upon a system

manufacture date.

For the purpose of keeping track of possible poor manufacturing from outside

vendors within a given time period.

Claims 7, 15 and 23.

Ferguson does not teach searching the solution network for general solutions

when no excursion solution exists, the searching the solution network to determine

whether an excursion solution exists being performed before searching to solution

network for general solutions.

Markham teaches searching the solution network for general solutions when no

excursion solution exists, the searching the solution network to determine whether an

excursion solution exists being performed before searching to solution network for

general solutions. (**Markham,** ¶0049; 'Solution network for general solutions' of

applicant is equivalent to Markham being integrated to outside systems for solutions.) It

would have been obvious to a person having ordinary skill in the art at the time of

applicant's invention to modify the teachings of Ferguson by having another source for

possible solutions as taught by Markham to search the solution network for general

solutions when no excursion solution exists, the searching the solution network to

determine whether an excursion solution exists being performed before searching to

solution network for general solutions.

For the purpose of having access to a possible solution when none could be

found when using the excursion solution system.

Conclusion

6.   The prior art of record and not relied upon is considered pertinent to the

applicant's disclosure.

-U. S. Patent Publication 2003004906: LaPointe

-U. S. Patent Publication 20010013026: Shaffer

-U. S. Patent Publication 20030167322: Butterworth

-U. S. Patent Publication 20030004904: Kishenbaum

-U. S. Patent Publication 20020181766: McClanahan

-U. S. Patent 5640491: Bhat

-U. S. Patent 6138115: Agrawal

-U. S. Patent 5799311: Agrawal

-U. S. Patent 6304864: Liddy

7.   Claims 1-24 are rejected.

Correspondence Information

8.   Any inquiry concerning this information or related to the subject disclosure should

be directed to the Examiner Peter Coughlan, whose telephone number is (571) 272-

5990. The Examiner can be reached on Monday through Friday from 7:15 a.m. to 3:45

p.m.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's

supervisor David Vincent can be reached at (571) 272-3080. Any response to this

office action should be mailed to:

Commissioner of Patents and Trademarks,

Washington, D. C. 20231;

Hand delivered to:

Receptionist,

Customer Service Window,
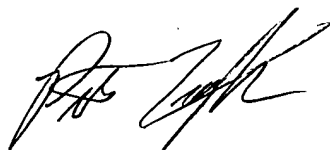
Randolph Building,

401 Dulany Street,

Alexandria, Virginia 22313,

(located on the first floor of the south side of the Randolph Building);

or faxed to:

(571) 272-3150 (for formal communications intended for entry.)

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have any questions on access to Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).

Peter Coughlan

3/15/2007

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